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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/646,346      | 11/15/2000  | Mario Pagliaro       | PAGLIAR01           | 9119             |

1444 7590 07/01/2003

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WASHINGTON, DC 20001-5303

EXAMINER

LEWIS, PATRICK T

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1623

DATE MAILED: 07/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                  |                 |  |
|------------------------------|------------------|-----------------|--|
| <b>Office Action Summary</b> | Application No.  | Applicant(s)    |  |
|                              | 09/646,346       | PAGLIARO ET AL. |  |
|                              | Examiner         | Art Unit        |  |
|                              | Patrick T. Lewis | 1623            |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 June 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-7,9-11,14-19 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-7,9-11,14-17,19 and 21-24 is/are allowed.
- 6) ☒ Claim(s) 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s). <u>13,14</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:   |

## **DETAILED ACTION**

### ***Objections/Rejections Set For the in Office Action dated April 7, 2003***

1. The rejection of claims 1-2, 8, and 20 under 35 U.S.C § 103(a), was maintained for the reasons of record set forth in the Office Action dated July 30, 2002.
2. Claim 19 was objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Applicant's Response dated June 6, 2003***

3. In the Response filed June 6, 2003, claim 19 was amended and claims 1-2, 8, and 20 were canceled. Claims 3-7, 9-11, 14-19, and 21-24 are pending. An action on the merits of claims 3-7, 9-11, 14-19, and 21-24 is contained herein below.
4. The rejection of claims 1-2, 8, and 20 under 35 U.S.C § 103(a), has been rendered moot in view of the amendments dated June 6, 2003.
5. The objection to claim 19 has been rendered moot in view of the amendments dated June 6, 2003.

### ***Examiner's Amendment***

6. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided

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by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Ann Kornbau on June 23, 2003.

The application has been amended as follows:

In claim 22, line 9, the term "4-oxy-TEMPO" has been deleted and the phrase ---4-oxy-2,2,6,6,-tetramethyl-1-piperidinyloxy (4-oxy-TEMPO)--- has been inserted therefor.

***Allowable Subject Matter***

7. The indicated allowability of claim 18 is withdrawn in view of Matsui et al. *Journal of Sol-Gel Science and Technology* (1997), Vol. 9, pages 273-277. Rejections based on the newly cited reference(s) follow.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by Matsui et al. *Journal of Sol-Gel Science and Technology* (1997), Vol. 9, pages 273-277. (Matsui).

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Matsui discloses TEMPOL, a potential nitroxyl precursor radical containing doping agent, used as a probe to measure organic molecular trapping of organic molecules in the preparation and testing of doped sol-gel glasses (page 273, columns 1-2). The measurement of a sol-gel doped with nitroxide radicals is verified via ESR. Matsui's nitroxide is seen to provide sufficient evidence that it is known in the art of doped sol-gel preparation to use nitroxide or nitroxyl precursors as applicant claim. A claim to a composition defined by reference to the process by which it is produced, is not limited to compositions produced by the process recited in the claim. Therefore, process limitation cannot impart patentability to a product which is not patentably distinguished over the prior art. *In re Thorpe et al.* (CAFC 1985) 779 F2d 695, 227 USPQ 964; *Scripps Clinic & Research Foundation v. Genentech, Inc.* (CAFC 1991) 927 F2d 1565, 18 PQ2d 1001. *Contra, Atlantic Thermoplastics Co. v. Faytex Corp.* (CAFC 1992) 970 F2d 834, 28 PQ2d 1481, rehearing denied, 23 PQ2d 180.

### **Conclusion**

10. Claims 3-7, 9-11, 14-19, and 21-24 are pending. Claim 18 is rejected. Claims 3-7, 9-11, 14-17, 19, and 21-24 are allowed.

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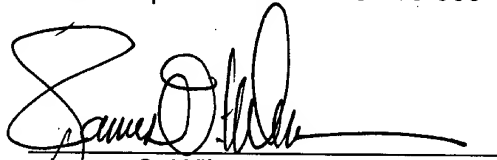
### **Contacts**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick T. Lewis whose telephone number is 703-305-4043. The examiner can normally be reached on M-F 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 703-308-4624. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Patrick T. Lewis, PhD  
Examiner  
Art Unit 1623



James O. Wilson  
Supervisory Patent Examiner  
Technology Center 1600

ptl  
June 30, 2003